

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 03752.400200 (formerly 02618.4006X0)	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on _____</p> <p>Signature: _____</p> <p>Typed or printed name: _____</p>		Application Number 10/511,163	Filed August 4, 2005
		First Named Inventor ARTHUR J. ROTH ET AL.	
		Art Unit 1794	Examiner E. Cole
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>44,749</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>		 <p>Signature Edmund J. Haughey</p> <p>Typed or printed name (202) 530-1010 Telephone number October 2, 2008 Date</p>	
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input checked="" type="checkbox"/> *Total of <u>2</u> forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including time for preparing, filling out and signing the completed application form to the USPTO. The time may vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
ARTHUR J. ROTH ET AL.) : Examiner: E. Cole
Application No.: 10/511,163) : Group Art Unit: 1794
Filed: August 4, 2005) : Confirmation No.: 9165
For: METHOD OF MAKING) :
COMPOSITE STRUCTURAL) :
MATERIAL) : October 2, 2008

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants request a pre-appeal brief review of the final Office Action mailed July 2, 2008, in the above-identified application. This Request is being filed concurrently with a Notice of Appeal. No amendments are being filed with this Request.

Claims 68-84, 88, and 120-125 are currently pending, of which claims 68 and 125 are independent. Claim 125 has been withdrawn from consideration.¹ Claims 68-84, 88, and 120-

¹ For the record, Applicants disagree with the Examiner's interpretation of the claims as expressed in the July 2, 2008 Office Action and the September 11, 2008 Advisory Action. Nonetheless, since an election-of-species requirement is not an appealable matter, Applicants will not further discuss it herein.

124 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,605,343 (Motoi) in view of U.S. Patent No. 5,474,721 (Stevens).

Both Applicants and the Examiner agree that Motoi discloses a composite material having a compliant surface layer -- preferably one that comprises a foamable resin, or, alternatively, a thermoplastic resin. This is not an arbitrary choice either, as Motoi repeatedly stresses that the composite material disclosed therein must have a sufficiently large bending modulus (e.g., Motoi, col. 7, lines 32-43), must be able to achieve long-term bending durability (e.g., Motoi, col. 7, lines 44-50), and must be able to easily absorb vibrations to reduce noise (e.g., Motoi, col. 25, lines 48-50).

By contrast, Applicants' invention, as recited in independent claim 68, recites steps including applying a non-foaming thermosetting-resin precursor mixture to a web material so as to impregnate the web material (step b) and allowing this thermosetting resin to set so that the web material is stiffened (step f).

The Examiner nevertheless asserts that it would have been obvious to substitute a non-foamable thermosetting resin, as allegedly disclosed by Stevens, for the foamable or thermoplastic surface layer resins taught by Motoi. Applicants strongly disagree. Such a modification would deprive the Motoi composite material of its essential characteristics and would render it unsatisfactory for its primary intended purpose, namely, for use as a railroad cross tie or "sleeper."

The July 2, 2008 Office Action, the September 8, 2008 Request for Reconsideration, and the September 11, 2008 Advisory Action discuss at length whether or not the combination of Motoi and Stevens is proper. Therefore, Applicants will not further rehash those arguments here. Rather, in this Request, Applicants wish to highlight a clear error in the Examiner's reading of

Motoi that makes the rejection unsustainable, even if one were to accept that the combination of Motoi and Stevens is proper -- which Applicants, of course, do not.

Applicants' independent claim 68 recites a method including, *inter alia*, steps of laying reinforcing cords on at least one side of a web material (step c) that, when the web material is formed into a sleeve-like configuration, faces the interior of the configuration (step d). Even the combination of Motoi and Stevens fails to teach or suggest these steps. At most, the Examiner's proposed modification of the Motoi manufacturing process would result in tanks 83 (shown in Fig. 13 of Motoi, which is reproduced below) dispensing a non-foamable thermosetting resin onto long fiber bundles 82, instead of dispensing the resins taught by Motoi.

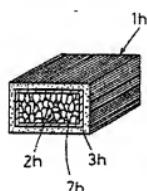


Fig. 12

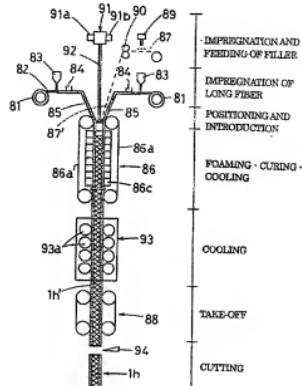


Fig. 13

The resin-impregnated long fiber bundles would then be passed through a movable mold 86 to form the surface layer 3h shown in Fig. 12 of Motoi (reproduced above). A sheet-like material 87 -- which forms the intermediate layer 7h shown in Fig. 12 -- would be "introduced into the movable mold 86 so that it can be located between the core layer 2h and the surface layer 3h in

the composite material 1h produced.” (Motoi, col. 28, lines 42-45; emphasis added.) The resulting structure would comprise, from inside to outside, the core layer 2h, the intermediate layer 7h (i.e., sheet-like material 87), and the surface layer 3h (i.e., the resin-impregnated long fiber bundles). Significantly, the long fiber bundles of Motoi would not be laid on the side of the sheet-like material 87 that faces the interior of the configuration. Indeed, just opposite would be true -- the long fiber bundles would be located outside of the sheet-like material 87.

On this point, the Examiner nevertheless asserts:

Motoi teaches that the outer layers of the composite material can comprise one or more layers of fibrous material such as parallel fibers, unidirectional fibers, bidirectional fibers and sewn mats. See col. 12, lines 14-27. Motoi further teaches additional reinforcing layers of paper can be added to the structure. See col. 18, lines 37-50. Therefore, the person of ordinary skill would have recognized that Motoi teaches the claimed elements and teaches that the elements can be combined by the process as set forth above at col. 27-29.

(July 2, 2008 Office Action, p. 4; emphasis added.)

This, Applicants submit, is a fundamental misreading of Motoi. The alleged “additional reinforcing layers of paper” discussed at col. 18, lines 37-50 of Motoi are actually part of the intermediate layer 7h of the Motoi composite material that is interposed between the core layer 2h and the surface layer 3h in order to enhance adhesion of the surface layer to the core layer. (Motoi, col. 18, lines 28-50; col. 29, lines 48-61; Fig. 12.) In other words, the so-called “outer layers” of the Motoi composite -- which the Office Action asserts “can comprise one or more layers of fibrous material such as parallel fibers, unidirectional fibers, bidirectional fibers and sewn mats” -- are positioned outside of the “additional reinforcing layers of paper” discussed at col. 18, lines 37-50 of Motoi. This is in stark contrast to Applicants’ invention, wherein reinforcing cords are laid on at least one side of the web material that, when the web material is formed into a sleeve-like configuration, faces the interior of the configuration.

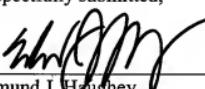
Curiously, in response to this argument by Applicants, the September 11, 2008 Advisory Action states that “the claims do not preclude an intermediate layer between the core and parallel strands” and “[t]he parallel strands would still face the interior, even if there is a layer between the parallel strands [and] the matrix.” While this observation regarding the scope of the claims is correct, the statement incorrectly presupposes that Motoi discloses a sheet-like material outside of the resin-impregnated long fibers. However, the Examiner has not identified it, and Applicants find no teaching of it. And, without it, the rejection cannot stand.

For at least the foregoing reasons, Applicants respectfully submit that there are clear errors in the outstanding rejection. Accordingly, Applicants request that the rejection be withdrawn and that a Notice of Allowance be issued in the subject application.

Applicants expressly reserves the right to assert additional errors in the outstanding rejection beyond those raised herein in a subsequent appeal brief or other response, should a Notice of Allowance not follow this submission.

Applicants’ undersigned attorney can be reached in the Washington, D.C. office of Fitzpatrick, Cella, Harper & Scinto by telephone at (202) 530-1010. All correspondence should continue to be directed to our address given below.

Respectfully submitted,



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